

Appl. No. : 10/791,688  
Filed : March 1, 2004

## REMARKS

By way of summary, Claims 1-78 were originally filed with the application. In a subsequent response to Restriction Requirement, the Applicant elected Claims 1-19, 25-45, and 68-78 and cancelled Claims 20-24 and 46-67 without prejudice. Accordingly, Claims 1-19, 25-45, and 68-78 remain pending in the application. By this amendment, Claims 4, 10, 11, 34, 43, and 78 are amended and no new claim is added.

### Claim Objections

In the Office Action, the Examiner objected to certain informalities in Claim 4. Specifically, Claim 4, line one refers to “The fence system of Claim 4”. At the suggestion of the Examiner, Claim 4 has been amended to read “The fence system of Claim 3”. The Applicant has also amended Claims 10 and 11, where the phrase “The fence system of Claim 10” has been amended to read “The fence system of Claim 9”. The Applicant requests reconsideration and withdrawal of this objection in light of these amendments.

### Claim rejections under 35 U.S.C. §112

In the Office Action, the Examiner rejected Claims 1, 15, 25, 34, 35, 43, and 78 as being indefinite under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner requested the Applicant to provide further clarification of the terms “substantial” or “substantially” in each of these claims. The Applicant has amended Claims 34, 43, and 78 to remove the term “substantially”. The Applicant further submits that the term “substantial fraying” as used in Claims 1, 25, and 35 refers to fraying that is exhibited in pickets formed by cutting cured fiber cement and the term “substantial separation” as used in Claim 15 refers to separation that is exhibited in pickets formed by cutting cured fiber cement. Accordingly, the Applicant respectfully requests the Examiner to withdraw the above rejection.

In the Office Action, the Examiner further rejected Claims 38, 39-41, 73, and 74 as being indefinite under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner indicated that the term “about” is an indefinite term and it is unclear what numerical value

**Appl. No.** : **10/791,688**  
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constitutes “about”. The Applicant respectfully disagrees with the Examiner that the term “about” is indefinite. The Applicant further submits that it is generally known that very few processes, if any, yield a precise and/or consistent measured value over time. As such, the term “about” refers to values that may fall within the standard deviation of a manufacturing and/or measuring process utilized to manufacture or measure the articles recited in these claims.

Accordingly, the Applicant believes that the claims comply with the requirements of 35 U.S.C. §112, second paragraph, and requests reconsideration and withdrawal of these rejections in light of this amendment.

**Claim rejections under 35 U.S.C. §103(a)**

The examiner rejected Claims 1-19, 25-45, and 68-78 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 3,801,072 to Newberry, Jr. (“Newberry”) in view of U.S. Patent Application Publication 2001/0047741 to Gleeson et al. (“Gleeson”). However, after careful review of the above indicated references, the Applicant notes that Newberry, with or without Gleeson, does not teach or suggest each and every limitation recited in independent Claims 1, 15, 25, 34, 68, and 72.

The Applicant respectfully disagrees that Newberry teaches a fence system comprising a mounting surface and a plurality of individual members attached to the mounting surface aligned in a manner so as to form a barrier as claimed in Claims 1 and 15 or a fence system comprising a plurality of pickets, as claimed in Claim 34. According to Newberry, “The fence panel simulates the appearance of a plurality of individual staves vertically arranged adjacent to each other as they would appear in a finished fence” (Column 3, Lines 60-63). Thus, Newberry teaches a fence system which *simulates but is not in fact* a plurality of individual members or pickets as claimed in certain preferred embodiments of the present invention.

Moreover, Newberry teaches away from the concept of employing individual members or pickets for use in a fence. As stated in Newberry, “since hand labor is required to construct wood fences at the site from preformed staves or planks, the total cost of a wood fence is quite excessive” (Column 1, Lines 18-21). Referring to the cost of using preformed staves or planks as “quite excessive” represents Newberry teaching away from the use of preformed staves or planks in fence systems.

**Appl. No.** : **10/791,688**  
**Filed** : **March 1, 2004**

The Applicant also respectfully disagrees with the Examiner's assertion that it would have been obvious to one of ordinary skill in the art to modify the fence panel as taught by Newberry to be constructed of fiber cement building material as taught by Gleeson to form a fence as claimed in the present application. Claim 1 relates to a fence system comprising, in part, at least one individual member or picket for a fence made of fiber cement whereby the at least one individual member or picket is made into desired shape prior to curing of the fiber cement and does not exhibit any substantial fraying of the at least one individual member along the surfaces after curing. Claim 15 relates to a fence system comprising, in part, at least one individual member made of fiber cement whereby the at least one individual member comprises a plurality of fiber cement layers and does not show substantial visible separation of the layers. Claim 25 relates to a picket for a fence wherein the least one picket for a fence made of fiber cement whereby the at least one individual member or picket does not exhibit any substantial fraying of the at least one individual member along the surfaces after curing. The at least one individual member or picket of these claims, in certain embodiments, is cut to size and shape prior to curing to provide a final product which *does not exhibit any substantial fraying along the surface or visible separation of the layers after curing*. See Paragraph 60, Lines 3-10 of the present specification.

Although the Gleeson reference discloses a fiber cement building material having low density additives and cellulose fibers, Gleeson does not disclose or suggest a fiber cement material for use in a fence which is made into a desired shape prior to curing and which does not exhibit any substantial fraying of the fibers on the surface or visible separation of the layers (also known as delamination) after curing. As stated in Gleeson, forming processes prior to curing (green forming) include "Hatscheck sheet process, Mazza pipe process, Magnani process, injection molding, extrusion, hand lay-up, molding, casting, filter pressing, flow on machine, roll forming, etc" (Paragraphs 29-38, Line 1, respectively). None of these forming processes provide a forming step to inhibit fraying or delamination damage in the as-cured product, such as cutting to size and shape prior to curing as described in the present specification. Therefore, Gleeson does not teach a method of producing a fiber cement product which does not exhibit any fraying along the surface or visible separation of the layers after curing. Thus, one skilled in the art would not be taught or suggested through Newberry and Gleeson, alone or in combination, to

Appl. No. : 10/791,688  
Filed : March 1, 2004

conceive of this embodiment of the invention. The Applicant therefore respectfully submits that Claims 1, 15, and 25 are allowable in light of the foregoing.

Furthermore, the Applicant respectfully disagrees that fiber cement would be considered suitable fencing which has a partially decorative function by one of ordinary skill in the art prior to the Applicant's disclosure. As disclosed in Newberry, a primary function of the fence is decoration, "the facsimile panel has the same general appearance as a fence constructed of the original material" (Col 1, Lines 41-42). Cutting to shape is a typical forming operation for fiber cement materials received from a manufacturer *in the as cured condition*. It is generally known that when cutting cured fiber cements, the side surfaces of the fiber cement that have been exposed to the cutting device typically exhibit damage. This damage can take the form of visible fraying of the fibers. Or in the case of fiber cements formed in lamination processes described in Gleeson, such as the Hatschek sheet process (Paragraph 29, Line 1) or hand lay-up (Paragraph 34, Line 1), this damage may manifest as separation of the cement fiber layers. These types of damage detract from the appearance of the fiber cement product.

Gleeson fails to discuss methods by which delamination and fiber fraying at the surface might be avoided. The only mention of damage inhibition in Gleeson is the suggestion that additions of volcanic ash or microspheres will reduce edge cracking or crumbling when a nail is inserted into a fiber cement board is nailed close to the edge (Paragraph 43, Lines 7-9 and Paragraph 63, Lines 10-12). Therefore, the disclosure that fiber cements may be applicable to fencing (Paragraph 107, Lines 1-5) would not be interpreted to include fences which have a partially decorative function by one of ordinary skill in the art. It is only in light of the Applicant's invention that fiber cement would be considered applicable to fences which have a partially decorative function. Accordingly, the applicant respectfully requests that the rejection of Claims 1, 15, 25, 34, 68, and 72 be withdrawn.

The Applicant also respectfully submits that the rejections to Claims 2-14, 16-19, 26-33, 35-45, 69-71, and 73-78 are moot in view of the Applicant's arguments above that independent Claims 1, 15, 25, 34, 68, and 72, which these claims depend from, are patentable over Newberry in view of Gleeson. Thus, the Applicant respectfully requests the withdrawal of these rejections.

Appl. No. : 10/791,688  
Filed : March 1, 2004

**Conclusion**

In view of the foregoing, the Applicant respectfully submits that all pending claims of the present application are in condition for allowance, and such action is earnestly solicited. Should there be any impediment to the prompt allowance of this application that could be resolved through a telephone conference, the Examiner is respectfully requested to call the undersigned at the number shown below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: 1/12/06

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